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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,268	03/17/2005	Wolfgang Rohde	LU 6051 (US)	4136
34872	7590	04/18/2008		
Basell USA Inc. Delaware Corporate Center II 2 Righter Parkway, Suite #300 Wilmington, DE 19803			EXAMINER TESKIN, FRED M	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			04/18/2008 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/528,268

**Applicant(s)**

ROHDE ET AL.

**Examiner**

Fred M. Teskin

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2008 and 14 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-30, 38-47, 54 and 55 is/are allowed.
- 6) ☒ Claim(s) 31-37 and 48-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20080114
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

This Office action follows an Amendment/Response and a supplemental Response respectively filed on January 4 and January 14, 2008. Claims 1-20 have been cancelled in favor of new claims 21-55, which are currently under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 37 is indefinite due to dependency on a cancelled claim (i.e., claim 1). Appropriate correction is required.

Claims 48-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 48 (and claims dependent thereon) is indefinite as it ostensibly claims an apparatus ("array of parallel reactors") but concludes with a "wherein" clause that effectively recites a use of that apparatus (claim 48, final five lines). It is unclear, therefore, whether infringement of the claim would occur when one creates an array of parallel reactors where each reactor comprises the "housing", "inlet" and "outlet" elements as recited therein, or whether infringement occurs when one actually passes a feed stream comprising at least one monomer through the respective reactor in such a

way that a fluidized bed of catalyst is produced. A single claim which claims both an apparatus and the method step(s) of using the apparatus is indefinite, see MPEP 2173.05(p).

Claims 31-33 and 48-50 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/44801.

Applicants have acknowledged that new claim 31 corresponds to previously pending claims 7 and 13; new claims 32, 33 correspond to previously pending claims 14, 15; new claim 48 corresponds to previously pending claims 8, 9 and 13; and new claims 49, 50 correspond to previously pending claims 14, 15 (Remarks, page 7). Previously pending claims 13-15 were rejected as anticipated by WO '801 based on the disclosure detailed on page 4 of the prior Office action. That rejection is deemed applicable to the new claims because the recitations of claim 7 and claims 8/9 now included in claims 31 and 48, respectively, are directed to intended manners of using the claimed apparatus (array of parallel reactors), which are not germane to the patentability of the apparatus itself. That is, the references in claim 31 to implementing a process for selecting Phillips catalysts, and those in claim 48 to a feed stream comprising at least one monomer being passed through the respective reactor in such a way that a fluidized bed of catalyst is produced, do not expressly or impliedly require any structure in addition to that described in WO '801. Thus the described array of parallel reactors possesses the structural elements of the applicants' array as claimed, any difference resides in the manner in which the array is to be used, and the manner in

which an apparatus is to be utilized is not germane to the issue of patentability of the apparatus itself. *See, In re Casey*, 152 USPQ 235 (CCPA 1967).

Claims 34-36 and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/44801.

WO '801 is applied as in the preceding rejection. Applicants have acknowledged (Remarks, page 7) that new claims 34-36 and 51-53 correspond to previously pending claims 16-18, which were rejected as unpatentable over WO '801 in the previous Office action, and do not dispute the stated rationale for that rejection (detailed on page 5 of said action). Accordingly, based on essentially the same rationale, WO '801 is deemed to render obvious the corresponding subject matter of claims 34-36 and 51-53.

Applicants' arguments filed January 4, 2008 with respect to WO '801 have been fully considered but are not persuasive of error in the repeated rejections.

Applicants essentially argue that claims 21-55 are patentably distinguishable from the prior art of record because they recite or otherwise include the subject matter of claims 7 and 9, which were indicated as allowable (if rewritten in independent form) in the previous Office action. Claims 7 and 9, however, are method claims which specified type of catalyst (Phillips) to be selected, or manner of feeding a feed stream, in certain embodiments of the applicants' claimed method. While the material on which a process (or method) is carried out must be accorded weight in determining the patentability of a process claim, patentability of an apparatus claim depends solely upon the structure of

the apparatus itself (see MPEP 2115). Applicants have not alleged much less shown wherein the inclusion in apparatus claims 31 and 48 of the recitations of allowable method claims necessarily creates an unobvious *structural* difference between the presently claimed array of parallel reactors and the corresponding apparatus of the applied art. Accordingly, the continued rejections based on WO '801 are still deemed tenable and therefore must be maintained.

Claims 21-30, 38-47, 54 and 55 are allowable on the present record. Claim 37 would be allowable if amended or rewritten to overcome the rejection under 35 U.S.C. 112 set forth in this Office action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fred M Teskin/

Primary Examiner, Art Unit 1796